

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

**BRIEF FOR APPELLANT
AND APPENDIX**

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8796 **595**

COMPANHIA ANTARCTICA PAULISTA, *Appellant*,

v.

CONWAY P. COE, Commissioner of Patents, *Appellee*.

Appeal from the District Court of the United States for the
District of Columbia.

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DISTRICT OF COLUMBIA

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IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8796.

COMPANHIA ANTARCTICA PAULISTA,
A Corporation of Brazil, *Appellant*,

v.

CONWAY P. COE, Commissioner of Patents, *Appellee*.

**Appeal from a Judgment of District Court of the United
States for the District of Columbia.**

BRIEF FOR APPELLANT.

JURISDICTIONAL STATEMENT.

The judgment appealed from was entered for the Commissioner of Patents, appellee, in a civil action in the District Court of the United States for the District of

Columbia, of which that Court had jurisdiction under Section 9 of the Trade-mark Act of February 20, 1905 (33 Stat. at L. 724, Chap. 592, U. S. C., Title 15, Sec. 89) and Section 4915 of the Revised Statutes (U. S. C., Title 35, Sec. 63). The judgment was a final one, dismissing the action. This court has jurisdiction under D. C. Code 1940, Title 17, Section 101, and Rule 10 (a) of this Court as amended, notice of appeal having been filed May 19, 1944, within three months after the entry of the judgment complained of on March 15, 1944.

STATEMENT OF CASE.

The appellant, hereinafter referred to as plaintiff, is a corporation of Brazil. On September 17, 1927 it obtained registration in that Country of its trade-mark "ANTARCTICA" for soft drinks and for syrups and extracts therefor. On July 7, 1941 it filed application Serial No. 445,112 in the United States Patent Office for registration in this Country of the same mark for the same goods, stating in its application that the trade-mark sought to be registered had been continuously used and applied to the goods in applicant's business since July 25, 1896 (Tr. 12).

The appellee, the Commissioner of Patents, hereinafter referred to as defendant, acting by the Examiner of Trade-marks, on January 30, 1942 refused registration of "ANTARCTICA" and thereupon plaintiff appealed from the decision of the Examiner of Trade-marks to the defendant, the Commissioner of Patents, who thereafter on November 18, 1942 affirmed the decision of the Examiner of Trade-marks, held plaintiff's trade-mark to be merely geographical, and refused registration of it (Commissioner's decision, Appellant's App. 9-10). The Commissioner cited no registered mark as being in conflict with that sought to be registered. Plaintiff then on March 18, 1943 brought this action (Appellant's App. 1).

PROCEEDINGS BELOW.

The answer admits all the allegations of the complaint saving only those of paragraphs 5 and 8, which were denied and which allege that plaintiff's application for registration is directed to a trade-mark registrable under the Trade-mark Act of February 20, 1905 and that defendant's refusal to register plaintiff's trade-mark is wrongful. Plaintiff has taken no appeal to the United States Court of Customs and Patent Appeals (Complaint, Appellant's App. 3; Answer, Appellant's App. 4).

The evidence is wholly documentary, neither party having taken the testimony of any witness. At the time of the trial oral argument was presented on behalf of both parties.

The trial Judge on March 7, 1944 filed an opinion (Appellant's App. 6) holding that plaintiff's trade-mark "ANTARCTICA" is "merely" a geographical term within the meaning of Section 5 of the Trade-mark Act of 1905 and, therefore, is not registrable under the Act. His judgment dismissing the action (Appellant's App. 6) was filed on March 15, 1944 accompanied with Findings of Fact and Conclusions of Law (Appellant's App. 6) corresponding to the holdings of his opinion.

STATUTE INVOLVED.

The portion of the Trade-mark Act of February 20, 1905 (33 Stat. at L., 724, Chap. 592) which has been held by the Commissioner of Patents and the District Court to prohibit the registration of plaintiff's trade-mark "ANTARCTICA" is Section 5 of that Act (U. S. C., title 15, sec. 85), the relevant part of which is as follows:

"That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark— * * *

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, * * * : *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: * * * .”

STATEMENT OF POINTS.

1. The Court erred in not correctly construing the words “merely a geographical name or term” contained in Section 5 of the Trade-mark Act of February 20, 1905 (33 Stat. at L. 724, Chap. 592, U. S. C., title 15, sec. 89).

2. The Court erred in finding that plaintiff’s trade-mark “ANTARCTICA” is a geographical name or term such as is forbidden registration by Section 5 of the Trade-mark Act of February 20, 1905 (U. S. C., title 15, sec. 89).

3. The Court erred in holding that the meaning of the words “merely a geographical name or term” appearing in Section 5 of the Trade-mark Act of February 20, 1905 (U. S. C., title 15, sec. 89) is clear and unambiguous on the face of the words.

4. The Court erred in failing to construe the words “merely a geographical name or term” of Section 5 of the Trade-mark Act of February 20, 1905 (U. S. C., title 15, sec. 89) in the light of and in harmony with the substantive law of trade-marks and in accord with the intention of Congress to permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the person using the same.

5. The Court erred in failing to hold that a geographical name or term used upon goods without descriptive significance as to the characteristics of the goods or of their

ingredients and not pointing either to the place of origin of the goods or their ingredients or to a place where the goods or their ingredients could originate, is used in an arbitrary and fanciful sense pointing solely to the producer of the goods, and is not "merely a geographical name or term" within the meaning of Section 5 of the Trade-mark Act of February 20, 1905 (U. S. C., title 15, sec. 89).

6. The Court erred in dismissing the complaint.

SUMMARY OF ARGUMENT.

Plaintiff asserts that the name "ANTARCTICA", its trade-mark for soft drinks, extracts and kindred goods, is arbitrarily and fancifully used upon its goods, since it conveys to the public no thought as to a locality where the goods or their ingredients are or could be produced, or as to the characteristics or qualities of the goods, and hence serves to identify plaintiff's goods from all others and is, therefore, a valid trade-mark at common law. It is not "merely a geographical name or term" within the meaning of Section 5 of the Trade-mark Act of February 20, 1905 (U. S. C., title 15, sec. 85) and is registrable under that Act.

The fundamental question presented by the case at bar concerns the proper construction of the words "merely a geographical name or term" employed in the Act.

(1) The Trade-mark Act of February 20, 1905 is a registration act. It is not an act creating any property rights in trade-marks. The Supreme Court of the United States has declared (a) that it was the intention of Congress in passing the Act to permit registration of all marks which could, under the common law as expounded by the courts, be exclusively appropriated as a valid trade-mark; (b) that the Act is to be examined in the light of the principles of common law relating to trade-marks and is to be construed in harmony therewith; and (c) that the Act should be interpreted to avoid refusal of registration under it, if that can be done by fair, even liberal, construction of it.

(2) The office of a trade-mark is to distinguish the goods of a particular manufacturer or trader from those of others. In general, a trade-mark may be any symbol, word or device, but it may not consist of any word or name properly used by another to explain a character or quality of his goods or their place of manufacture or origin. By identifying the commercial source of the goods, a trade-mark guarantees the genuineness of the goods to the public and at the same time enables their producer to enjoy whatever benefits may rightfully result from the reputation of his goods.

(3) Property in trade-marks is not created by and does not rest upon an act of Congress but rests upon common law. It specifically rests upon the substantive law of trade-marks forming a part of the general law of unfair competition. Any mark, not of scandalous or immoral import or otherwise against public policy, which when first adopted and used upon the goods serves to distinguish the goods to which it is applied as coming from a particular producer or trader, is a true trade-mark, valid at common law.

In the case of a true or technical trade-mark, no particular period of continued use is required to create a property right therein. Such rights as may be acquired in all other "marks," not true trade-marks, must be acquired not merely by first use of the mark upon the goods, but, in addition, by continued use to such extent as will ultimately create in the public mind an association between the mark and the particular user of the mark. True trade-marks are registrable; marks which do not *ab initio* signify to the public the ownership or personal origin of the goods are not true trade-marks, nor does the subsequent acquirement by a mark of a secondary meaning pointing to a particular trader convert it to a true trade-mark. Marks which are dependent on a "secondary meaning" to signify personal origin of the goods are not registrable at all

except under the special provisions of the so-called "ten year clause" of the Act.

(4) Under the substantive law of trade-marks it is unquestionable that a geographical name or term used upon the goods in a purely arbitrary and fanciful sense, not reasonably conveying to the public mind the idea of place of origin of the goods or of their ingredients, is a legitimate and valid trade-mark.

The doctrine of the substantive law of trade-marks concerning the appropriation of geographical names or terms is that a geographical name or term which points to the *place* of production of the goods, not to the producer, is not a good trade-mark. And the same is true of a geographical name which is descriptive of the ingredients of the goods or designates the place where they are or could be produced. This is so because there can be no exclusive right to a geographical name as against others who have an equal right to use it by reason of residence or otherwise. A right which is a common right of all cannot be exclusively appropriated. Where, however, a geographical word is used arbitrarily and fancifully, and obviously with no reference to any place where the goods are or could be manufactured or from which their ingredients are or could be derived, no person other than the first user has any peculiar right to make a similar use of that word.

A fanciful and arbitrary, obviously non-descriptive, use of a geographical name upon goods creates a common law trade-mark, for the name as thus used is understood by the public to identify not a place having any connection with the origin of the goods but to signify the producer of them and it, therefore, is quite as much a trade-mark as any other non-descriptive word performing the function of a trade-mark. This is sound doctrine.

(5) "ANTARCTICA" is a fanciful designation, arbitrarily selected by plaintiff to signify to the public the personal origin of the goods. Obviously it would be so understood by the public. It could not reasonably be regarded

otherwise for it is common knowledge that the region "ANTARCTICA" is totally uninhabited, a land of perpetual snow and ice, incapable of supporting human life. No commerce exists between it and any part of the world. No intelligent person, therefore, would ever entertain a belief that "ANTARCTICA" used on goods indicates the locality where the goods or their ingredients are manufactured or produced, any more than he would believe that the word "Brobdingnag", the land of the giants of Swift's Gulliver's Travels, if appearing as a "mark" on an article of trade, signified that the article was produced there. Realizing the commercial impossibility of any goods coming from "ANTARCTICA", it would be immediately obvious to the public that the "mark" is used on the goods not as signifying place of origin but in a purely arbitrary and fanciful sense, as a trade-mark, to indicate the personal origin or producer of the goods. Any other deduction would be against ordinary common sense.

(6) Whether plaintiff's trade-mark "ANTARCTICA" is entitled to registration under the Trade-mark Act in question depends upon the interpretation proper to be given the words "no mark * * * merely a geographical name or term, shall be registered under the terms of this Act" which appear in section 5.

In determining their meaning these words should not be considered abstractly but, as the Supreme Court of the United States has declared, they should be examined in the light of and construed in harmony with the substantive law of trade-marks. Decisions of the highest authority show that prior to the passage of the Trade-mark Act of February 20, 1905, the words "merely geographical" were employed in the substantive law of trade-marks to mean geographical names or terms which, as "marks" affixed to the goods, signify to the public mind a *place* of origin of the goods without indicating anything in the nature of manufacture or ownership of the goods. This meaning of the

words "merely geographical" must, under the established rule of construction, be presumed to be the sense in which Congress used those words in section 5 of the Trade-mark Registration Act of February 20, 1905. Any other meaning applied to them would be inconsistent with the meaning attached to them in the common law of trade-marks.

The statute was not intended to prohibit and does not by its terms prohibit registration of *every* geographical name. It simply prohibits registration of any "mark" which is "*merely* a geographical name or term". By using the adverb "merely" to qualify the words "a geographical name or term", Congress plainly recognized the common law principle that a name or term, though geographical, is nevertheless a legitimate trade-mark if when affixed to the goods it indicates to the public the producer of the goods and is not understood by the public as simply signifying a place where the goods or their ingredients are or could be manufactured or produced. Recognizing that common law principle Congress must be presumed to have legislated in harmony therewith and to have used advisedly the qualifying word "merely" with the intent of allowing registration of a geographical term which is used not as "merely a geographical name or term", but is used in an arbitrary and fanciful sense and hence is a valid trade-mark at common law, while precluding registration of "marks" consisting of geographical terms merely used descriptively of place of origin of the goods or of their ingredients.

Apart from any consideration of the substantive law of trade-marks, the presence of the word "merely" in the phrase "merely a geographical name or term" indicates that it was not the intention of Congress to preclude registration of *all* geographical names or terms, with no regard to whether they were or were not valid trade-marks at common law. If the contrary had been the intention, the qualifying word "merely" should have been omitted, making the phrase read "no mark * * * a geographical name or term, shall be registered under the terms of this Act".

The qualifying word "merely" may not be entirely disregarded so as to impart to the phrase "*merely* a geographical name or term" used in the Act identically the same meaning as if it read "a geographical name or term" without any qualification. To do so, would violate ordinary rules of interpretation. It would also, as has been said, be in disregard of the principles of the substantive law of trade-marks, and would be contrary to the declared intention of Congress to provide for the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark.

(7) "ANTARCTICA", as a trade-mark for soft drinks, extracts and the like, is a valid trade-mark at common law and is registrable under the Trade-mark Act of February 20, 1905. The judgment of the lower court should be reversed.

ARGUMENT.

The question here presented is whether, when properly construed, section 5 of the Trade-mark Act of February 20, 1905 (U. S. C., title 15, sec. 86), by stating that "no mark * * * merely a geographical name or term, shall be registered under the terms of this Act", precludes registration of *all* geographical names or terms; and, if not, whether it permits registration of those geographical names or terms, valid trade-marks at common law, which are used in an arbitrary and fanciful sense and have as associated with the goods no geographical significance as to any place where the goods or their ingredients are or could be produced.

Stated otherwise, does a proper construction of the words "no mark * * * merely a geographical name or term" appearing in the statute forbid registration of a geographical name which is a valid trade-mark at common law?

General Nature and Interpretation of the Trade-Mark Act.

The Trade-mark Act of February 20, 1905 U. S. C., title 15, sec. 81-109) is a registration act; *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 543, 64 L. ed. 705, 707. It does not change the substantive law of trade-marks forming a part of the general law of unfair competition; *American Steel Foundries v. Robertson*, 269 U. S. 371, 381, 79 L. ed. 317.

The Supreme Court of the United States has declared that it must be assumed that, when the registration statute of February 20, 1905 was enacted, Congress must have had in mind the principles of the substantive law of trade-marks and that the provisions of the Act are to be construed in harmony with the established principles of that substantive law; *American Steel Foundries Case, supra*. And in that case also, adverting to the intention of Congress in respect to the registration of such marks as the substantive law of trade-marks recognized as legitimate, it was pointed out that—

“The House Committee on Patents, in reporting the bill which upon enactment became the registration statute in question said: ‘Section 5 of the proposed bill, we believe, will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark’ ”.

And in *Beckwith v. Commissioner of Patents*, 252 U. S. 538, the Supreme Court observed that the Trade-mark Act of February 20, 1905 was designed to promote the domestic and foreign trade of our country, and declared that refusal to register a mark under that Act should be “avoided” if that can be done “by fair, even liberal, construction of the act”.

Respecting the interpretation of the Trade-mark Act in question, the United States Supreme Court has, therefore, laid down these rules:

(1) that the act must be examined in the light of and construed in harmony with the principles of the substantive law of trade-marks and unfair competition.

(2) that to the extent the contrary does not appear from the act the intention of Congress was to allow the registration of such marks as the substantive law of trade-marks, and the general law of unfair competition of which it is a part, recognized as legitimate, and

(3) that the owner of a trade-mark valid at common law should not be denied the benefits of registration under the act, if that can be avoided by fair, even liberal, construction of the act.

In the *American Steel Foundries Case*, 269 U. S. 372, the Court had the duty of determining the construction to be placed upon one of the prohibiting clauses of Section 5 of the Trade-mark Act of 1905, not however the specific clause here involved. Three questions had been certified to the court, but for "purposes of discussion" it resolved them into one, namely "upon the facts, is the word 'Simplex' merely the name of the Simplex Electric Heating Company within the meaning of the quoted proviso?" As to this question, the court said (379):

"The answer to this question will be simplified if we approach it by first considering certain principles of the substantive law of trade-marks and unfair competition, in the light of which the legislation under review must be examined."

The court then reviewed and analyzed the principles of substantive law of trade-marks dealing with the appropriation and use of trade-marks identical with and similar to the names of corporations and, in referring to them, stated (page 381):

"These principles, it must be assumed were in mind when Congress came to enact the registration statute. And, since that body has been given no power to legis-

late upon the substantive law of trademarks, it reasonably may be assumed, also, that, to the extent the contrary does not appear from the statute, the intention was to allow the registration of such marks as that law, and the general law of unfair competition of which it is a part, recognized as legitimate. The House Committee on Patents, in reporting the bill which upon enactment became the registration statute in question, said: 'Section 5 of the proposed bill we believe will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trademark.' Report No. 3147, Dec. 19, 1904, H. of R., 58th Cong., 3d Sess.

"The provision, therefore, that no mark consisting merely in the name of a corporation shall be registered, is to be construed in harmony with those established principles in respect of the appropriation of corporate names to which we have referred."

In the *Beckwith Case*, 252 U. S. 538, 546, the Supreme Court declared that the Trade-mark Act of 1905 should be liberally construed, saying:

"Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed, as it is, to promote the domestic and foreign trade of our country."

These authoritative statements as to the interpretation of the Trade-mark Act of 1905, are directed to the Act in general and consequently apply to the specific part of it here involved.

In interpreting the Act, it is to be noted also, as the Supreme Court has stated in the *Beckwith Case*, that the initial provision of Section 5 of the Act, "That no mark * * * shall be refused registration as a trade-mark" except in certain designated cases, is quite as imperative as the prohibitory words of the proviso against registration of

specified kinds of marks. It is generally indicative of the broad intent of the statute.

Office of a Trade-mark.

The office of a trade-mark is to distinguish, to set apart, the goods of a particular trader from those of another. Its purpose is to enable the purchaser or consumer to identify the commercial source of the goods, to the end that the public may know the maker or seller of the goods and the maker or seller enjoy such reputation as his goods deserve. A trade-mark has been called the "commercial signature" of a trader. It is a mark of authenticity of the goods.

As the United States Supreme Court has succinctly put it, in *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 673, "It (a trade-mark) may consist in any symbol or in any form of words" which performs the office of a trade-mark "to point out distinctively the origin or ownership of the articles to which it is affixed * * *"

Defined in general terms, a trade-mark may be said to consist of any distinctive mark which serves to distinguish the personal origin of the goods to which it is affixed and which other traders have no occasion to use to describe their goods or the characteristics of their goods. Distinctive marks of this character can be exclusively appropriated as trade-marks by their first user because they convey no meaning which would give the first user an unfair advantage over others in the sale of his goods. Other marks are not subject to exclusive appropriation; they are only protected from being copied in a form in which they would permit the "palming off" of goods in unfair competition.

Nature of Property Right in Trade-marks and Other Marks Used on Goods.

Property in trade-marks is not created by and does not rest upon an act of Congress. It rests upon common law, specifically the substantive law of trade-marks which forms a part of the general law of unfair competition.

A trade-mark, as that term is used in the common law, is a true or technical trade-mark, a definite thing. The first user of such a mark acquires the exclusive right to its use on the goods to which he has applied it. This right to exclusive use of a technical trade-mark extends to any form in which the mark may be used and is brought into being with its first use. Rights in other marks, not true or technical trade-marks, must be acquired by such long use of the mark as will finally cause the public to associate it with the goods of a particular producer or trader.

Property rights in marks which are not true trade-marks are qualified and arise only as the result of long use. They can be enforced, not to the extent of preventing others from using them in any form (for they convey meanings which other traders may find it necessary to impart to the public concerning the nature or character of their goods) but only to the extent of requiring that others use them in such manner that the public will not be misled as to the *personal* origin of the goods. Such marks are commonly referred to in the law of unfair competition as marks which have acquired a "secondary" meaning, by which is meant that they have come at last in the public mind to identify a particular manufacturer, producer or trader, despite the fact that the primary interpretation placed upon the "marks" by the public was that they did not identify any particular trader. *Thaddeus Davids Co. v. Davids*, 233 U. S. 466, 470.

No question of "secondary" meaning of the mark "ANTARCTICA" is here involved. The primary significance to the public of the mark "ANTARCTICA", when it is seen associated with the goods, is that it is a trade-mark, not that it signifies place of origin of the goods.

Geographical Names Arbitrarily and Fancifully Used are Valid Trade-marks at Common Law.

Under the substantive law of trade-marks a geographical name or term used upon an article of commerce in a purely arbitrary and fanciful sense, not conveying to the public the idea of the place of origin of the article or of its ingredients, is a valid trade-mark.

The doctrine of the substantive law of trade-marks concerning the appropriation and use of geographical names or terms is that a geographical name or term which the public would understand to point to the *place* of production of the goods, not to the producer, is not a legitimate trade-mark; and the same is true of a geographical name which points to the place of origin of the ingredients of the goods or designates a place where the goods or their ingredients could be produced. This is so because there can be no exclusive right to the use of a geographical name as against others who have an equal right to use it by reason of residence in the designated place or otherwise. Such words are without trade-mark significance because they do not identify the particular producer or seller of the goods. Where, however, a geographical word is used arbitrarily and fancifully, and obviously with no reference to the place where the goods are or could be manufactured or from which their ingredients are or could be derived, no person other than the first user has any peculiar right to make a similar arbitrary, non-descriptive, fanciful, use of that word. Such words are valid trade-marks because they perform the function of a true trade-mark, that is to say, they identify the particular manufacturer or producer of the goods.

Tested by the fundamental principle of the substantive law of trade-marks, that a mark to be a trade-mark must identify the maker or producer of the goods, most geographical names or terms are such that they fail to indicate to the public mind the maker or producer of the goods to which they are applied, and they, therefore, do not perform

the office of a trade-mark. Most of them when first used signify in the public mind nothing more than or different from the *place* of manufacture or origin of the goods to which they are affixed, and hence their significance to the public is "*merely geographical*". A fanciful use of a geographical term, on the contrary, creates a common law trade-mark, for the term as so used does not connote in the mind of the public the idea of place of origin of the goods but serves to identify the personal origin or producer of the goods. It, therefore, is quite as much a legitimate trade-mark as any word or symbol which performs the office of a trade-mark.

The rule that geographical names or terms which are arbitrarily and fancifully used to distinguish the producer of the goods are valid trade-marks at common law is expressed in the "Restatement of the Law—Torts" Section 720, as follows:

"A geographical name cannot be a trade-mark for goods unless

(a) the use of the name in connection with such goods is not likely to be understood by purchasers as representing that the goods or their constituent materials were produced or processed in the place designated by the name or that they are of the same distinctive kind or quality as the goods produced, processed or used in that place, * * * ."

Under the authorities, it is unquestionable that a geographical term used, as is "ANTARCTICA", in an arbitrary and fanciful sense, without geographical significance as to place of origin of the goods, is a valid trade-mark.

In *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 673, holding that "Elgin" is not a valid trade-mark for watches, the Supreme Court pointed out that geographical names or terms which merely signify the place where an article is manufactured or produced and which do not indicate the personal origin, manufacture or ownership of the goods are not trade-marks, saying:

“The term (trade-mark) has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words, but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trade-mark which, from the nature of the fact conveyed by its primary meaning, others may employ with equal truth and with equal right for the same purpose.”

“And the general rule is thoroughly established that words that do not in and of themselves indicate anything in the nature of origin, manufacture, or ownership, but are *merely descriptive of the place where an article is manufactured or produced*, cannot be monopolized as a trade-mark.” (Italics added)

The teaching of the Elgin case is that any symbol or word which performs the office of pointing out distinctively the owner or producer of the articles to which it is affixed is a valid trade-mark, but that a geographical name which is “merely descriptive of the place where the article is manufactured or produced” is not a good trade-mark since it does not fulfill the essential requirement of a trade-mark, namely that it must indicate the particular producer of the goods. And accordingly the court held in respect to the mark “Elgin” that “*this geographical name*” was incapable of exclusive appropriation as a trade-mark, saying (677):

“And since, while the secondary signification attributed to its use of the word might entitle appellant to relief, the fact that, *primarily, it simply described the place of manufacture*, and that *appellees had the right to use it in that sense*, though not the right to use it without explanation or qualification, if such use would be an instrument of fraud, we are of opinion that the general rule applied, and that *this geographical name* could not be employed as a trademark, and

its exclusive use vested in appellant, and that it was not properly entitled to be registered as such.” (Italics added)

In *Delaware & Hudson Canal Company v. Clark*, 13 Wall. 311, 20 L. ed. 581, where the question was whether the geographical name “Lackawanna” was a valid trade-mark for coal mined in a district of that name, the United States Supreme Court pointed out the reason why a geographical name or term which indicates the place where the goods are produced is not a valid trade-mark. After stating that the “office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, to give notice who was the producer”, and after noting, therefore, that “a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics” cannot “be employed as as trade-mark and the exclusive use of it be entitled to legal protection”, the court said (324):

“And it is obvious that the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of *geographical names*, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. *They point only at the place of production, not to the producer*, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies. Could such phrases as ‘Pennsylvania wheat,’ ‘Kentucky hemp,’ ‘Virginia tobacco,’ or ‘Sea Island cotton,’ be protected as trademarks; could any one prevent all others from using them or from selling articles *produced in the districts* they describe under those appellations,—it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common right of many. It can be permitted only when the reasons that lie at the foundation of the pro-

tection given to trademarks are entirely overlooked.”
(Italics added)

And the Court then proceeded to say (p. 327):

“It must then be considered as sound doctrine that no one can apply the name of a district of country to a well known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others *inhabiting* the district or dealing in similar articles *coming from the district* from truthfully using the same designation.” (Italics added)

It likewise appears from the opinion of the Court in *Brown Chemical Co. v. Meyer*, 139 U. S. 540, 35 L. ed. 247, and the cases there cited, that all geographical names are not to be considered as being incapable of performing the office of a valid trade-mark, but that they cannot be monopolized as trade-marks if they do not point to the manufacturer or producer of the goods, and instead are merely descriptive of the character, qualities or composition of the article or of the place where the goods are manufactured or produced. In the opinion in that case, Mr. Justice Brown said (542):

“The general proposition is well established that words which are merely descriptive of the character, qualities or composition of an article, or of the *place* where it is manufactured or produced cannot be monopolized as a trade-mark.” (Italics added)

Federal and state courts have recognized almost uniformly that trade-marks which are geographical names are valid when used in an arbitrary and fanciful sense. See for example: *Manitou Springs Mineral Water Co. v. Schueler*, 239 F. 593, 601 (8 C. C. A.), certiorari denied 243 U. S. 645; *Scandinavia Belting Co. v. Asbestos & Rubber Works*, 257 F. 937, 950-952 (C. C. A. 2); *Jewish Colonization Association v. Solomon & Jermansky*, 154 F. 157 (S. D. N. Y.); *Carmel Wine Co. v. Palestine Hebrew Wine Co.*, 161 F. 645 (S. D. N. Y.); and *Katschinski v. Keller*, 49 Cal. App. 406,

193 Pac. 587, citing *Drake Medicine Co. v. Glessner*, 68 Ohio St. 337, 67 N. E. 722, and *Sanders v. Utt*, 16 Mo. App. 322.

See also the list of cases cited in the foot-note of Volume 45, Lawyer's Edition of the Supreme Court Reports, at page 370, where it is said:

“The rule that there can be no trade-mark in a geographical name is not applicable where the name was arbitrarily or fancifully selected to indicate origin and ownership and not the place of production.”

And Nims, in his work on “Unfair Competition and Trade-marks” (3rd edition, page 276), states that geographical names used arbitrarily and obviously with no reference to places they identify are valid trade-marks. He says (page 276):

“Any obviously non-descriptive use of a geographical term makes it quite as much a trade-mark as any other non-descriptive word. It is the meaning of the term, to the public, when seen or heard in its trade use, not whether the word has or has not a geographical meaning, that counts.

“Frequently, courts state that a geographical name never can be a common-law trade-mark. That is not an accurate statement. A strictly non-descriptive use of a geographical term may create a common law trade-mark, because the term so used identifies the source of the goods and is used fancifully, not descriptively, and hence may lawfully be appropriated by the user.”

Plaintiff's Trade-mark “ANTARCTICA” is Fancifully Used.

“ANTARCTICA” is a geographical name. But as a “mark” associated with plaintiff's goods it is purely fanciful, arbitrarily selected by plaintiff to indicate the manufacturer or producer of the goods. The public could not reasonably regard it in any other sense. It could not reasonably be regarded by the public as indicating the *place* of manu-

facture of the goods or the place from which ingredients of the goods are derived, for it is common knowledge that the vaguely defined region called "ANTARCTICA" is totally uninhabited and is a land of perpetual snow and ice incapable of supporting human life (National Geographic Magazine, August 1920, page 127 et seq.). It is manifestly impossible for any one to engage in business in "ANTARCTICA" or for commerce to exist between it and any part of the world. No one could have occasion to employ "ANTARCTICA" in his business in the sense of indicating or describing his goods as coming from that region. The use of "ANTARCTICA" as a trade-mark therefore does not interfere with or embarrass any public or private right.

No intelligent person, seeing "ANTARCTICA" affixed to the goods, would ever entertain a belief that it signified the locality where the goods or their ingredients were manufactured or originated, any more than he would believe that the word "Brobdingnag", the land of the giants of Swift's Gulliver's Travels, if affixed to an article of trade, signified that the article was produced there. Recognizing the commercial impossibility of producing any goods in "ANTARCTICA", it would be immediately apparent to the public that the mark "ANTARCTICA" is used on the goods in a purely arbitrary and fanciful sense and, to the exclusion of all else, is to identify the particular manufacturer or producer of the goods. No other deduction would be reasonable or sensible. Any other deduction would be absurd and against common sense.

The Proper Construction of the Pertinent Words of Section 5 of the Act Involved.

Section 5 of the Trade-mark Act in question provides that "no mark * * * merely a geographical name or term, shall be registered under the terms of this Act".

Registration under the Act of plaintiff's trade-mark "ANTARCTICA" depends upon the proper interpretation

of those words. If their proper interpretation is that *no* geographical name or term is registrable, even though it be a valid trade-mark at common law, then registration of "ANTARCTICA" has been properly denied. If, however, the proper construction of the words "merely a geographical name or term" does not exclude registration of a geographical name which is used fancifully and is without significance as to the place where the goods or their ingredients are or could be produced, then "ANTARCTICA" is registrable.

This Court has said in *McIlhenny v. New Iberia E. of T. P. Co.*, 34 App. D. C. 430, 432:

"Sec. 5 of said trade-mark act (33 Stat. at L. 726, chap. 592, U. S. Comp. Stat. Supp. 1909, p. 1278) prohibits the registration of any mark 'merely a geographical name or term'. This provision is simply declaratory of the common law, * * *."

As the provision of Section 5 prohibiting registration of any mark "merely a geographical name or term" is declaratory of the common law, it should not be construed abstractly but, as the Supreme Court of the United States has said in *American Steel Foundries v. Robertson*, 269 U. S. 372, should be examined in the light of and construed in harmony with the substantive law of trade-marks. Construed in the light of the substantive law of trade-marks it gives effect to the declared intention of Congress to permit the registration of all marks which could, under the common law as expounded by the courts, be exclusively appropriated as a valid mark.

It uniformly appears from decisions of the United States Supreme Court dealing with the appropriation of geographical names as trade-marks that under the substantive law of trade-marks, as expounded by the courts prior to the Act in question, geographical names or terms which when used upon the goods signify to the public merely the *place* of origin of the goods, or their character, qualities or ingredients, cannot be exclusively appropriated

by any one trader, because all traders have an equal right to employ them in that same sense. Geographical names so used, not indicating anything as to the personal origin of the goods, have been said by the Supreme Court to be "*merely geographical*", "*merely a geographical name*" and "*merely descriptive of the place where an article is manufactured or produced*" (Italics added).

As the Supreme Court of the United States plainly points out in *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, 466, "*merely geographical names*" are those which "do not, in and of themselves, indicate anything in the nature of origin, manufacture or ownership". In that case the alleged trade-mark was the geographical word "Columbia" as a mark for flour. The court held it to be in the category of "*merely geographical names*", such as "the word 'America', or 'United States', or 'Minnesota', or 'Minneapolis,'" and as to it being "*merely geographical*" in a trade-mark sense the court said "the word 'Columbia' gives no information on the subject of origin, production or ownership". The court said:

"The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade-mark than he would have been to the use of the word 'America,' or 'United States,' or 'Minnesota', or 'Minneapolis.' These *merely geographical* names cannot be appropriated and made the subject of exclusive property. They do not in and of themselves, indicate anything in the nature of origin, manufacture, or ownership; and in the present case the word 'Columbia' gives no information on the subject of origin, production or ownership." (Italics added.)

It will be observed that in that case the words "*merely geographical names*", which in plural form are those appearing in the provision of Section 5 of the Act relating to the registration of geographical names or terms, were used as appropriate to describe a geographical name (Columbia) which, as a "mark" applied to the goods was without trade-mark significance.

In the Elgin case, 179 U. S. 665, 45 L. ed. 365, it was sought to enjoin the use of the alleged trade-mark "Elgin". In the opinion in that case, Mr. Chief Justice Fuller referred (674) to the name "Elgin" as "*merely* a geographical name", and it was held that the name "Elgin" could not be appropriated as a trade-mark under the thoroughly established general rule "that words that do not in and of themselves indicate anything in the nature of origin, manufacture or ownership, but are merely descriptive of the place where an article is manufactured or produced cannot be monopolized as a trade-mark" (673), it being pointed out that names which are "merely descriptive of the place" where an article is manufactured or produced do not perform the office of a trade-mark and cannot be monopolized since it properly can be used by others inhabiting that place or dealing in similar articles coming from there.

And later (674) adverting to the contention that the name "Elgin" should not be "treated as merely a geographical name" because it has acquired a "secondary signification", the court pointed out that whereas the right to the use of a word which is a true trade-mark is absolute and exclusive, the right to the use of a word "not in itself a good trade-mark", but which by use has acquired a secondary signification denoting a particular manufacturer or vendor, is not absolute but is limited to "requiring the use of the word by another to be confined to its primary sense by such limitations as will prevent misapprehension on the question of origin". This, of course, is the distinction between the substantive law of trade-marks and the broader aspect of the law of unfair competition.

See also *Delaware & Hudson Canal Co. v. Clark*, 80 U. S. 311, 324, which points out that:

"The same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical

names, designating district or country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the *place* of production, not to the producer * * * ." (Italics added)

The words "merely geographical" of Section 5 of the Trade-mark Act are to be understood in accordance with their meaning in the substantive law of trade-marks at the time the Act was passed, as expounded by the decisions of the United States Supreme Court. To apply any other meaning to them would be inconsistent with the common law of trade-marks.

The doctrine of the substantive law of trade-marks respecting use of geographical names or terms, as has been said, is not that *all* geographical names or terms are not legitimate trade-marks. Similarly Section 5 of the Trade-mark Act does not indiscriminately prohibit registration of *all* geographical names. To construe it otherwise would be to disregard the declared intention of Congress to permit registration under the Act of all marks which are good trade-marks at common law.

The statute, it is submitted, simply prohibits registration of a trade-mark which is "*merely* a geographical name or term". Congress cannot be presumed to have used the qualifying word "*merely*" inadvisedly and in a sense different from that in which it is used in the substantive law of trade-marks. By employing the adverb "*merely*" to qualify the words "a geographical name or term" Congress plainly recognized the common law principle that any name or term, even though geographical, is a valid trade-mark if it indicates to the public the producer of the goods and is not merely used descriptively of the characteristics, qualities or ingredients of the article or to identify a place where the article is or could be manufactured or produced.

As has been heretofore noted, the House Committee on Patents, in reporting the bill which became the registration

statute in question, said: "Section 5 of the proposed bill we believe will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark" (Report No. 3147, Dec. 19, 1904, H. of R. 58 Cong., 3d Sess.)

The intention of Congress thus expressed would fail of accomplishment unless the words "merely a geographical name or term" are construed so as to distinguish geographical names fancifully used, which are good trade-marks at common law, from geographical names merely used descriptively to indicate a place from which the goods or their ingredients may come, which are not good trade-marks at common law. It is not to be presumed that Congress in passing the Act in question intended to discriminate among valid trade-marks, permitting registration of some and denying it to others.

Apart from the consideration that the Trade-mark Act of 1905 should be construed in harmony with and in the light of the substantive law of trade-marks, the presence of the word "merely" in the phrase "merely a geographical name or term" may not be disregarded.

"Congress is not to be presumed to have used words for no purpose"; *Platt v. Union Pacific R. R. Co.*, 99 U. S. 44. "Every statute must be construed from the words in it, and that construction is to be preferred which gives to all of them an operative meaning"; *Early v. Doe ex dem. Homans*, 57 U. S. 610, 617.

To construe the statute as though the word "merely" does not appear in the phrase "merely a geographical name or term" is to treat that qualifying word as superfluous and to give it no effect. Some meaning should be given to the word "merely" in relation to the word "geographical" which it qualifies, and that meaning should, if possible, be the one which those words had in the substantive law of trade-marks at the time the registration statute was passed. Only in this way can the statute be

construed, as the Supreme Court says it must, in harmony with the substantive law of trade-marks and to give effect to the intention of Congress.

The words "geographical" and the words "merely geographical" are not to be construed as having the same import. Obviously the words "no mark * * * merely a geographical name or term, shall be registered under the terms of this act" cannot be understood as if the word "merely" were omitted so as to make the phrase become "no mark * * * a geographical name or term, shall be registered under the terms of this act". The phrase omitting the word "merely" would be a plain declaration by Congress that *no* geographical name or term whatsoever was registrable under the Act. But the phrase used by Congress includes the word "merely" and is an equally plain declaration that geographical names or terms used as "marks" on articles of trade are registrable unless they are "merely" geographical.

The word "mark" is obviously used in the statute to mean a mark affixed to the goods. The meaning of such a "mark" is, in the sense of the substantive law of trade-marks, its significance to the public when it is seen associated with the goods. If, therefore, the significance to the public of a geographical name or term when seen as a "mark" affixed to the goods is primarily that it identifies the particular producer of the goods, distinguishing him from other producers of similar goods, the "mark" is not "*merely* a geographical name or term", because its meaning to the public as associated with the goods is that it does not indicate place of origin of the goods, but signifies something different, something not geographical, namely, the particular producer of the goods.

Whether a "mark" affixed to the goods of a trader is or is not "*merely* a geographical name or term" is determined by its signification to the public when associated with the goods. If the "mark" is a geographical name signifying to the public simply the place where an article is produced,

it is "merely a geographical name" under the principles of the substantive law of trade-marks and in the sense that phrase is used in that law. If, however, the "mark" is a geographical name which, by reason of its arbitrary and fanciful use or otherwise, signifies to the public the particular producer of the goods to which it is affixed, distinguishing him in the public mind from other producers of similar goods, then that "mark" is not "merely a geographical name" in the sense of the substantive law of trade-marks. Such construction of the words "merely a geographical name or term" appearing in Section 5 of the Trade-mark Act is in strict harmony with the common law of trade-marks and gives effect to the intention of Congress in enacting that registration statute. To construe it in any other manner would not only violate ordinary rules of interpretation but would be to disregard the principles of the substantive law of trade-marks and ignore the express intention of Congress to permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark. As was said in *ex parte Crew Levick Company*, 1918 C. D. 51, 255 O. G. 160:

"There is always danger of error in these cases of alleged descriptive or geographical words unless the reason for the law be constantly borne in mind. Whether a term is geographical or not must depend in the last analysis upon the question whether the public might suppose that the term indicated a place from which the goods came, and this because the only reason Congress had for prohibiting the registration of geographical names was that it would interfere with the rights of others who had an equal right with the applicant to say that their goods came from that place."

The case of *In re Crescent Typewriter Supply Co.*, 30 App. D. C. 324, is in full harmony with the proper interpretation of the provision here under consideration of the

Trade-mark Act. It was there held that the word "Orient" is a geographical name or term "which would convey to the public mind but one meaning, namely, that the goods manufactured by the appellant company possessed qualities or elements that distinctively belong to the oriental countries"; and it was, therefore, held that "the word 'Orient', we think, is *such* a geographical term as comes clearly within the prohibition of the statute". The decision in that case, by exploring the geographical significance which might be attached in the public mind to the word "Orient" and stating that the "purpose of the statute is to prevent a manufacturer or dealer from gaining" any advantage over other traders resulting from that significance, makes it clear that the court had constantly in mind the principles of the substantive law of trade-marks and recognized that, in the sense of the Act, the meaning of a "mark" is the significance of the "mark" to the public in relation to the goods to which it is affixed.

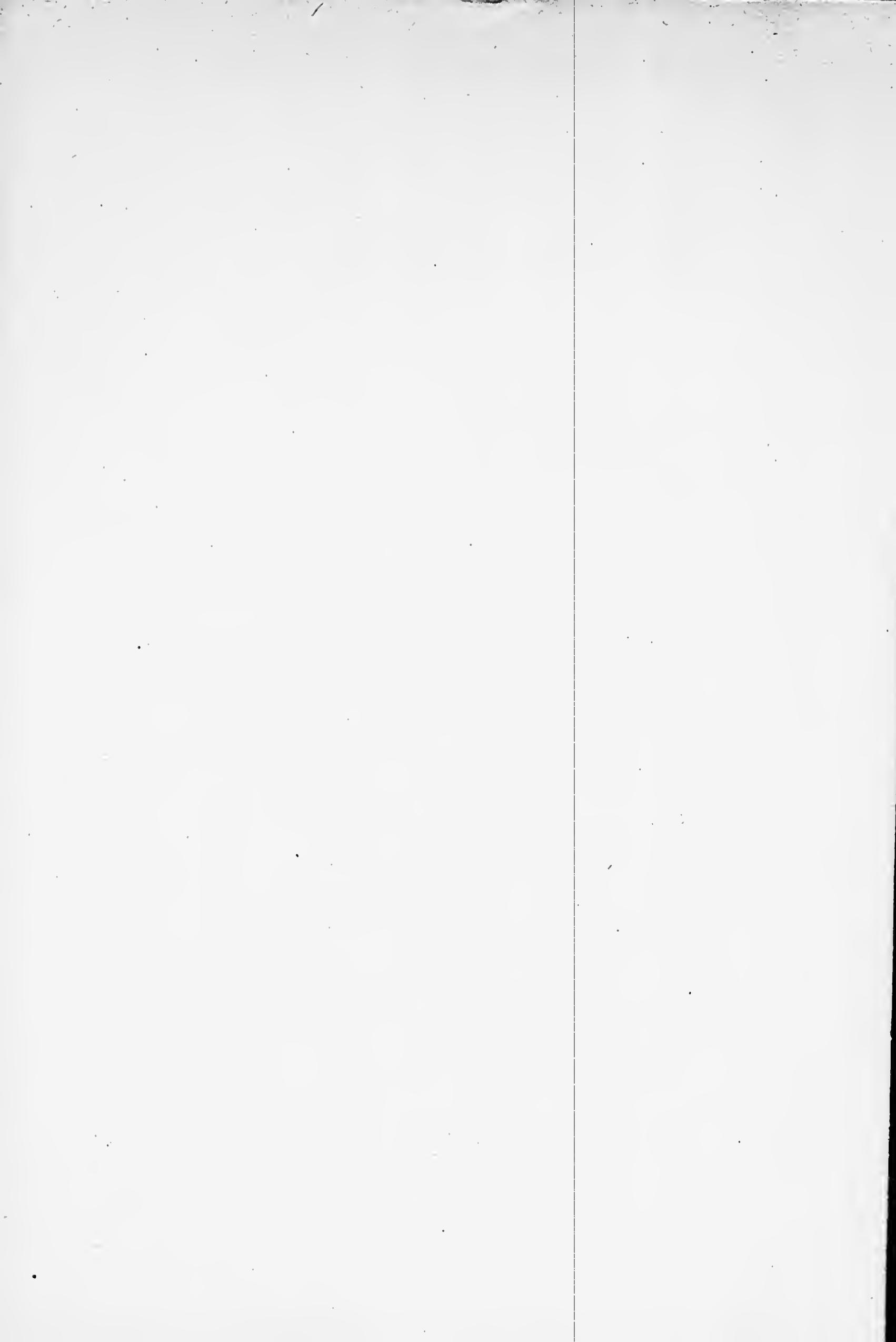
CONCLUSION.

In conclusion it is submitted that "ANTARCTICA", as a trade-mark for soft drinks, extracts and kindred goods, is a valid trade-mark at common law and is registrable under the Trade-mark Act of February 20, 1905. "ANTARCTICA", while a geographical name or term, is not "*merely* a geographical name or term" within the meaning of the Act. It points to the producer of the goods, not to their place of production; its use is purely arbitrary and fanciful; it is not descriptive of the goods or of their ingredients; its use gives to the plaintiff no unfair advantage in trade over any one.

The judgment of the lower court should be reversed.

GILBERT P. RITTER,
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Of Counsel.



APPENDIX

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IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8796.

COMPANHIA ANTARCTICA PAULISTA, *Appellant,*

v.

CONWAY P. COE, Commissioner of Patents, *Appellee.*

Appeal from the District Court of the United States for the
District of Columbia.

APPENDIX.

**PLEADINGS, DOCKET ENTRIES AND OTHER
PAPERS DESIGNATED.**

1

Filed Mar 18 1943

In the District Court of the United States for the
District of Columbia

Civil Action No. 19006

COMPANHIA ANTARCTICA PAULISTA, A Company of Limited
Responsibility, 274 Avenida Presidente Wilson, Sao
Paulo, State of Sao Paula, Brazil, *Plaintiff*

v.

CONWAY P. COE, Commissioner of Patents, *Defendant*

Complaint

To the District Court of the United States for the District
of Columbia:

1. This action arises under Section 9 of the Trade-Mark Act of February 20, 1905, U. S. C., Title 15, Section 89, and under Section 4915 of the Revised Statutes, U. S. C., Title 35, Section 63.

2. The plaintiff is a company of limited responsibility, duly organized and existing under the laws of Brazil and having its principal place of business at 274 Avenida Presidente Wilson, Sao Paulo, State of Sao Paulo, Brazil, which country by treaty and convention affords to owners of trade-marks who are citizens of the United States similar privileges of obtaining registration for said trade-marks as are accorded by the laws of the United States to owners of trade-marks who are citizens of Brazil.

3. The defendant, Conway P. Coe, is the Commissioner of Patents of the United States, is officially a resident of the District of Columbia, and is sued as Commissioner of Patents of the United States.

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4. On July 7, 1941, plaintiff duly filed an application in the United States Patent Office under the pro-

visions of the Trade-mark Act of February 20, 1905 (U. S. C., Title 15, Sections 81-108, both inclusive) for the registration of its trade-mark "Antarctica" for natural mineral waters, non-alcoholic maltless beverages sold as soft drinks and syrups and extracts for making soft drinks, which said application became identified as Serial No. 445,112, the said trade-mark "Antarctica" having been theretofore registered by plaintiff for the same goods in Brazil on September 17, 1927 as No. 24,689.

5. The said application Serial No. 445,112 is directed to a trade-mark registrable under the said Trade-mark Act of February 20, 1905 and under the rules of the Patent Office relating to the registration of trade-marks.

6. The said application Serial No. 445,112 was filed and has been prosecuted in accordance with the laws of the United States and the said rules of the Patent Office, but the defendant, by the examiner of trade-marks, did refuse registration of the said trade-mark for which plaintiff filed said application.

7. Plaintiff appealed from the decision of the examiner of trade-marks to the defendant, the Commissioner of Patents, and in a decision dated November 18, 1942 defendant affirmed the decision of the examiner of trade-marks and held plaintiff's said trade-mark to be merely geographical, and defendant thereupon refused registration of the said trade-mark.

8. Defendant has wrongfully refused and still wrongfully refuses to register plaintiff's said trade-mark on said application.

3 9. Plaintiff has taken no appeal to the United States Court of Customs and Patent Appeals from the said decision of the defendant, dated November 18, 1942 refusing to register plaintiff's said trade-mark, and has performed all conditions precedent to the maintenance of this action imposed by the laws of the United States and the said rules of the Patent Office.

Wherefore, being dissatisfied with the said decision of the defendant, plaintiff prays that it be held entitled to have its said trade-mark registered, and that defendant be directed to cause the said trade-mark to be published in the Official Gazette of the Patent Office in accordance with the provisions of Section 6 of said Trade-mark Act of February 20, 1905, U. S. C., Title 15, Section 86.

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* * * * *

4

Filed Apr 12 1943

Answer to the Complaint.

To the Honorable the Justices of the District Court of the United States for the District of Columbia.

1, 2, 3, 4. Defendant admits the allegations of paragraphs 1 to 4, inclusive.

5. He denies the allegations of paragraph 5.

6, 7. He admits the allegations of paragraphs 6 and 7.

8. He admits that he has refused and still refuses to register to plaintiff the term ANTARCTICA as a trade-mark, for which plaintiff made its application No. 445,112 on July 7, 1941. He denies that his refusal is wrongful or that plaintiff is lawfully entitled to registration of the said term ANTARCTICA. He states that said term is merely a geographical term and therefore is not registrable under the Trade-Mark Act of February 20, 1905 (U. S. C., title 15, sec. 85), which more fully appears from

5

the statement of the Examiner in answer to the appeal and the decision of the Commissioner, copies of which will be furnished at the trial.

9. He admits the allegations of paragraph 9.

W. W. COCHRAN
Solicitor, U. S. Patent Office,
Attorney for Defendant.

April 10, 1943.

I hereby certify that a copy of this Answer to the Complaint was mailed today, April 10, 1943, to the attorneys for plaintiff, Messrs. Ritter, Mechlin & Muir, 724 Tower Building, Washington, D. C.

W. W. COCHRAN
Solicitor.

• * • • • • • • • •

6

Filed Mar 7 1944

Opinion of Justice Bailey

The plaintiff sought the registration of his trade-mark "Antarctica" and the Commissioner of Patents refused to register it.

The Trade-mark Act of 1905 authorizes the registration of trademarks

"Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act."

The plaintiff argues that it was the intention of Congress to allow the registration of such mark as the substantive law recognized as legitimate at the time of the passage of the Act, and as the word "Antarctica" does not imply the origin of the plaintiff's products of mineral waters, soft drinks, etc. or their place of manufacture it does not come within the proviso of the Act.

But the word "Antarctica" is clear and "merely" a geographical term and when an Act of Congress is clear on its face and in no way ambiguous, it must be taken to mean what it says. I agree with the Commissioner of Patents in denying the registration of the word "Antarctica" and the plaintiff's complaint will be dismissed with costs.

JENNINGS BAILEY

Justice

* * * * *

7

Filed Mar 15 1944

Findings of Fact

1. This is an action under R. S. 4915 (U. S. C., title 35, sec. 63) in which the plaintiff sought to have the Court authorize the registration of the word "ANTARCTICA" as a trade-mark for natural mineral waters, non-alcoholic, maltless beverages sold as soft drinks and syrups and extracts for making soft drinks.

2. The word "ANTARCTICA" is clear and is merely a geographical term.

Conclusions of Law

1. The prohibition in the trade-mark act of 1905 against the registration of a mark which consists of merely a geographical name or term is clear on its face and
8 in no way ambiguous and it must, therefore, be taken to mean what it says.

- 2. Plaintiff is not entitled to the registration of the word "ANTARCTICA" as a trade-mark.
- 3. The complaint should be dismissed.

JENNINGS BAILEY
Justice.

March 15th, 1944.

• * • • • • • • • •

9 Filed Mar 15 1944

Judgment

This action came on to be heard at this term and thereupon, upon consideration thereof, it is, this 15th day of March, 1944,

Adjudged that the complaint in this case be, and the same hereby is dismissed with costs against the plaintiff.

JENNINGS BAILEY
Justice.

Approved as to Form:
HENRY K. MUIR
Attorney for Plaintiff.

• * • • • • • • • •

10 Filed May 19 1944

Notice of Appeal

Notice is hereby given this 19th day of May 1944 that Companhia Antarctica Paulista, the plaintiff above named, hereby appeals to the United States Court of Appeals for

the District of Columbia from the final judgment entered in this action on March 15, 1944.

GILBERT P. RITTER

HENRY K. MUIR

Attorneys for Plaintiff,

724 Tower Building,

Washington 5, D. C.

RITTER, MECHLIN & MUIR,

Of Counsel,

724 Tower Building,

Washington 5, D. C.

• * • • • • • • • •

Exhibits for Defendant

16

Filed Jun 1 1944

FAR/F

Paper No. 8

In the United States Patent Office

Applicant: Companhia Antarctica Paulista.

Trade-Mark for Natural Mineral Waters, etc.

Serial No. 445112, filed July 7, 1941,

Attorneys: Ritter, Mechlin & Muir,

Tower Building,

Washington, D. C.

Before the Commissioner on Appeal

Examiner's Statement

This is in answer to an appeal from the Examiner's refusal to register to applicant the mark "ANTARCTICA" on the ground that the term is merely geographical. Webster defines "Antarctica" as "The Antarctic Continent". The Court of Customs and Patent Appeals has said:

“Geography relates to towns, countries and subdivisions thereof, mountains, valleys, rivers, etc., the names of which suggest fixed locations.” (In re California Perfume Company, Inc., 420 O. G., 289; 56 F. (2d) 885.)

The name “Antarctica” suggests a fixed location. It has no other substantial meaning. Even the definition “Matters connected with the antarctic”, given as “rare”, refers only a little less directly to a fixed location.

It is believed that registration is properly refused.

Very respectfully,

F. A. RICHMOND

Examiner of Trade-Marks

April 1, 1942.

17 Hearing:
July 15, 1942

LB
CA 19006

In the United States Patent Office

Ex Parte Companhia Antarctica Paulista

Appeal

Application for registration of trade-mark for soft drinks,
etc., filed July 7, 1941, Serial No. 445,112.

Ritter, Mechlin & Muir for applicant.

Decision of First Assistant Commissioner of Patents

This is an appeal from the refusal of the examiner of trade-marks to register the word “Antarctica,” under the

Act of February 20, 1905, as a trade-mark for soft drinks, etc., on the ground that such word is "merely a geographical name or term," and thus forbidden registration by the second proviso of section 5 of that Act.

Counsel for applicant insist that geographical terms should be registered, in spite of this statutory restriction, unless "descriptive of the place where the articles, to which the terms are applied, are manufactured or produced or might be understood as being manufactured or produced." And with respect to applicant's mark they have the following to say in their brief:

"Although being the name of a geographical region, it is not 'merely' geographical for it is not descriptive of the place where applicant's goods are produced or of a
18 place where the public might reasonably suppose they were produced, since the region it describes is uninhabited by any living thing. Being totally uninhabited, no one would believe or be deceived into believing that applicant's goods are produced in Antarctica and the term, therefore, as applied to applicant's goods has no geographical significance whatever."

Counsel for applicant have presented a very able argument as to what they think the law should be, and I am inclined to share their opinion in that regard; but I am unable to read into the Act the construction for which they contend. If a word has no other meaning, as is conceded to be the case here, it is of course "merely" geographical; and regardless of all other considerations, the statutory bar to registration is absolute. In *re Kraft-Phenix Cheese Corporation*, 28 C. C. P. A. 1153, 120 Fed. (2d) 391; In *re Crescent Typewriter Supply Company*, 30 App. D. C. 324. In the case last cited, the Court of Appeals of the District of Columbia said:

"We think this provision of the statute is broad enough to prohibit the use of any word that has an exclusive geographical significance, or that would suggest any particular

geographical location. Certainly, the use of a name indicating a particular place is prohibited, such as the name of a city, or country, or subdivision of a country. With equal certainty do we think that it prohibits the use of a name that applies to a particular section of the globe * * *."

It is my opinion that applicant's mark as presented was properly refused registration, and the examiner's decision is accordingly affirmed.

LESLIE FRAZER

First Assistant Commissioner

November 18, 1942

* * * * *

19

Filed May 29 1944

Stipulation of Designation of Record on Appeal

It is stipulated by and between the parties hereto, in accordance with Rule 75(f) of the Rules of Civil Procedure, that the complete record and all proceedings and evidence herein be designated as the record on appeal in this case, as follows:

1. Complaint
2. Answer
3. Opinion
4. Judgment
5. Findings of Fact and Conclusions of Law
6. The following exhibit for plaintiff:

Certified copy of application for trade-mark registration Serial No. 445,112 comprising Petition, Statement and Power of Attorney, the Declaration and the Drawing.

7. The following exhibits for defendant:
 - a. Copy of Examiner's Statement, dated April 1, 1942

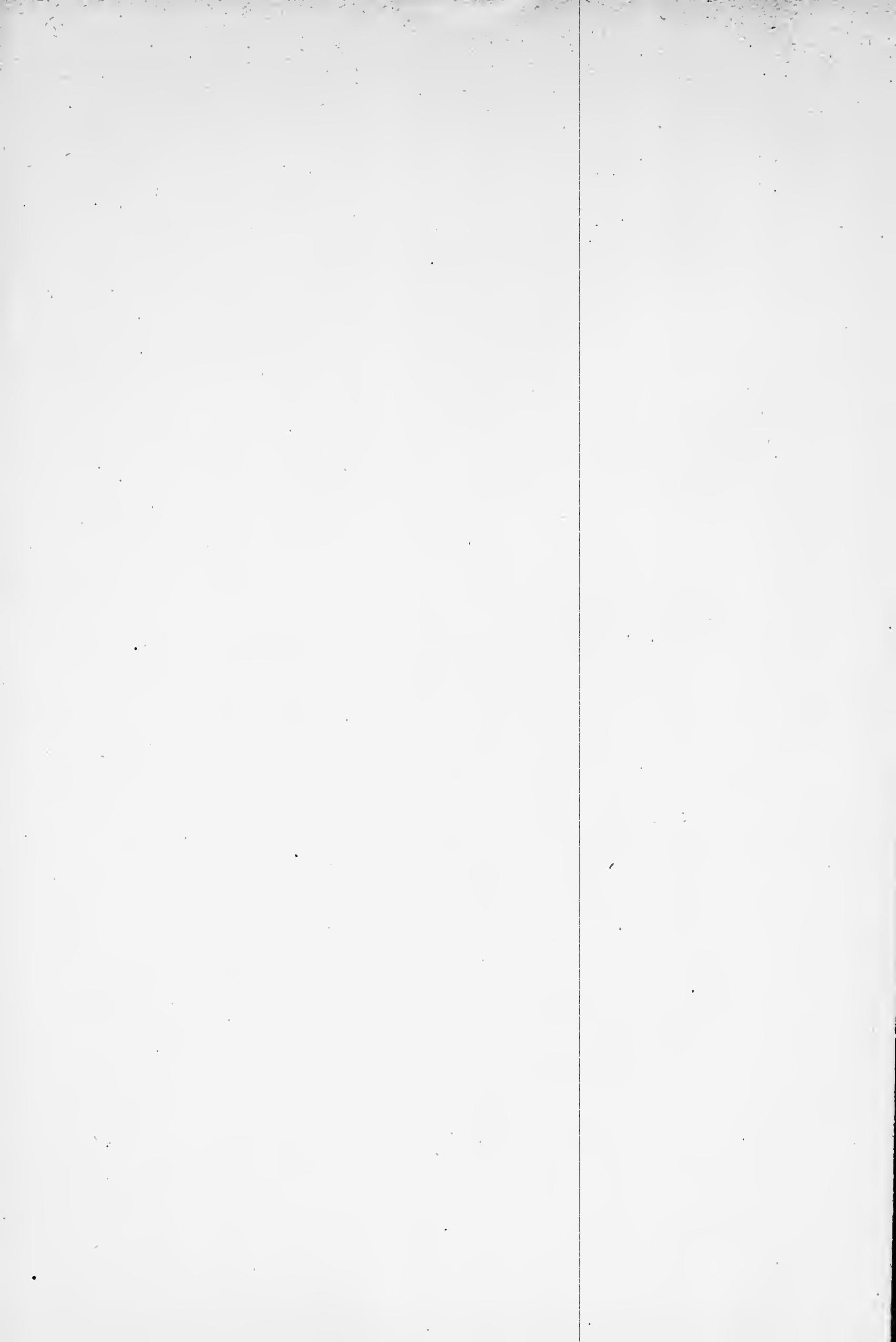
b. Copy of decision of First Assistant Commissioner of Patents, dated November 18, 1942.

20 8. This Designation of Record.

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Washington 5, D. C.

W. W. COCHRAN
Solicitor for Commissioner of Patents,
Washington, D. C.

• • • • •



UNITED STATES
COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA

FILED SEP 15 1944

Joseph W. Stewart

CLERK

BRIEF FOR APPELLEE

United States Court of Appeals

DISTRICT OF COLUMBIA

APPEAL No. 8796

COMPANHIA ANTARCTICA PAULISTA, APPELLANT

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA

W. W. COCHRAN,
Solicitor, United States Patent Office.
Attorney for Appellee.

E. L. REYNOLDS,
Of Counsel.

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United States Court of Appeals

DISTRICT OF COLUMBIA

APPEAL No. 8796

COMPANHIA ANTARCTICA PAULISTA, APPELLANT

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

*APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA*

BRIEF FOR THE COMMISSIONER OF PATENTS

INTRODUCTION

This is an appeal from the judgment of the District Court of the United States for the District of Columbia (7)¹, dismissing appellant's complaint in an action under R. S. 4915 (U. S. C., title 35, sec. 63), seeking to have the Court authorize the registration by the Commissioner of Patents of the word "Antarctica" as a trade-mark for beverages.

SUMMARY OF ARGUMENT

1. Section 5 of the trade-mark act of 1905 prohibits the registration of a mark which is merely a geographical name.

¹ The numbers in parentheses refer to pages of appellant's appendix.

2. The word "Antarctica" is merely a geographical name within the meaning of this section.

ARGUMENT

Section 5 of the trade-mark act of 1905, under which the appellant seeks registration, provides that no mark shall be registered which consists in "merely a geographical name or term." The sole question to be decided in this case is whether the word "Antarctica" is such a name or term. Webster's New International Dictionary defines "Antarctica" as "the antarctic continent," and also (rare) as "matters connected with the antarctic." Both these meanings are clearly geographical, and the appellant does not suggest that the word has any other recognized meaning. In fact, it is conceded on page 15 of the appellant's brief that "No question of 'secondary' meaning of the mark 'Antarctica' is here involved." "Antarctica," therefore, is clearly "not otherwise than" geographical, and Webster defines "merely" as "not otherwise than."

It will thus be clear that, giving the words their commonly accepted meaning, "Antarctica" is merely a geographical name, and the appellant's argument is based on the contention that these words, as used in the statute, must be given a meaning other than the ordinary one, this contention, in turn, being predicated on assertions as to what the common law of trade-marks was and what Congress must have intended by section 5 of the trade-mark act.

Obviously, the words used in the act provide the best evidence of the intention of Congress, and if

these words are clear and unambiguous, no other evidence as to their meaning is admissible. The following authorities support this proposition:

Crawford, Statutory Construction, Section 185, P. 315:

As we have hitherto stated, the intention of the legislature is to be primarily ascertained from the language used in the statute, and if the language is plain and unambiguous, it must be given a literal meaning. It is subject to construction only when its meaning is not clear.

Endlich—Interpretation of Statutes, Section 2, P. 4:

The first and most elementary rule of construction is that it is to be assumed that the words and phrases are to be used in their technical meaning if they have acquired one, and in their popular meaning if they have not—words of common use are to be understood in their natural, plain, ordinary, and genuine signification as applied to the subject matter under enactment.

Section 4, P. 6:

It is, therefore, only in the construction of statutes whose terms give rise to some ambiguity, or whose grammatical construction is doubtful that courts can exercise the power of controlling the language in order to give effect to what they suppose to have been the real intention of the lawmakers.

Black on Interpretation of Laws, Section 8, Page 16:

The first resort in all cases is to the natural signification of the words employed in the

order and grammatical arrangement in which the framers of the instrument have placed them. If, thus regarded, the words embody a definite meaning, which involves no absurdity and no contradiction between the different parts of the same writing, then that meaning, apparent in the face of the instrument, is the one which, alone, we are at liberty to say was intended to be conveyed. In such a case there is no room for construction. That which the words declare is the meaning of the instrument and neither courts nor legislatures have the right to add to or take away from that meaning.

The words "merely," "geographical," "name," and "term" are all in everyday usage and have generally accepted and well understood meanings. In accordance with such meanings a word which denotes a particular location and nothing else is, without exception, "merely a geographical name or term." No sufficient reason is shown here for restoring to any other interpretation. It is immaterial what marks were valid at common law. The appellant is seeking registration under a specific statute and he must comply with the express terms thereof.

The literal interpretation of the language in question was definitely adopted by this Court in the case of *In re Crescent Typewriter Supply Co.*, 30 App. D. C. 324, wherein it was said:

It will be noted that this section 5 of the Trade-Mark Act does not permit the use of "a geographical name or term." *We think this provision of the statute is broad enough to pro-*

hibit the use of any word that has an exclusive geographical significance or that would suggest any particular geographical location. Certainly, the use of a name indicating a particular place is prohibited, such as the name of a city or country or subdivision of a country. With equal certainty do we think that it prohibits the use of a name that applies to a particular section of the globe. [Italics added.]

The Court of Customs and Patent Appeals arrived at a similar interpretation in *In re Kraft-Phenix Cheese Corp.*, 120 F. (2d) 391; 28 C. C. P. A. 1153. In that case it was sought to register the word "Chantelle," which is the name of a small town in France, and the identical argument was made which is advanced here by the appellant, namely that no one would suppose that the product to which the mark was applied originated in this town, since the word "Chantelle" had no geographical significance to purchasers in this country. The Court, however, followed the literal wording of the statute and held the mark not registrable, relying in part on the *Crescent Typewriter Supply* case cited above.

It appears to be argued on page 28 of the appellant's brief that his mark is not merely geographical because, when affixed to the goods, it signifies the producer of the goods. This position seems clearly untenable. No mark can be registered under the act of 1905 which has not been previously used in commerce and, accordingly, if such use of a geographical term prevented it from being merely geographical, the portion of the act here under consideration would

have no force whatever, since no mark which could qualify for registration in other respects could be merely geographical. Clearly, therefore, the fact that appellant has applied the word "Antarctica" to its goods does not prevent it from being merely geographical.

It is significant that, to offset the clear literal meaning of the statute and the interpretation given in the above-cited decisions, the appellant, despite what has obviously been a very thorough search of the authorities, has been unable to cite a single instance in which it has been held proper to register, under the act of 1905, a mark which had no significance other than geographical. Instead, it is argued that the common law must be read into the statute, and that the mark here involved would have been proper at common law. It is submitted that neither of these propositions is sound.

As is shown by the authorities above cited, extrinsic sources may not be relied on to interpret a statute unless the language used, considered alone, is ambiguous. If the meaning of the words used is clear, it cannot be distorted on the theory that the legislative body must have meant something other than what it plainly said. The appellant urges that word "merely" should not be held to have been used "in a sense different from that in which it is used in the substantive law of trade-marks;" but it is not shown where this word is used in such substantive law, nor what it has been interpreted to mean. It is the word "geographical" which is used there, and not the words "merely geo-

graphical." So far as appears, the word "merely" in this connection, was first used in the act itself and has no established special meaning in connection with "geographical."

The appellant also argues that, if the word "merely" does not have the meaning which he contends for, it has no meaning at all. This, however, is not the case. There are many words which, although the names of places, have additional primary or secondary meaning. Examples of another primary meaning are St. Paul, Santa Claus, and Golden. Examples of another secondary meaning are Cashmere, Gibraltar, and Frankfurt. Such words, having meanings other than geographical, are not merely geographical, and it was obviously to exclude them that the word "merely" was inserted in the statute.

It will thus be seen that the meaning of the statute as it stands is perfectly clear and unequivocal and that there is no justification for resorting to common law or any other extrinsic source to explain it.

Moreover, it is not thought that the word "Antarctica" would be a proper trade-mark at common law. It is by no means clear that a word having no meaning other than geographical is a proper common law trade-mark if it is so used that no one would consider it to indicate the source of the goods on which it is used. Certain of the authorities cited by the appellant would appear to support this view, although many of them are based merely on "secondary meaning." There is, however, authority to the contrary. Thus in *La Republique Francaise et al. v. Saratoga*

Vichy Springs Co. (C. C. A., second circuit), 107 Fed. 459, it was said that:

It is true that a mere geographical name, without attending facts which have caused the name to become significant of a particular manufacture and to identify the manufacture as the product of a particular person, is not the subject of a trade-mark.

And in *Columbia Mill Co. v. Alcorn et al.*, 150 U. S. 460, the unequivocal statement was made that "Such Trade-Mark cannot consist of words in common use as designating locality, section, or region of country." It was also said that the word "Columbia" gives "no information on the subject of origin, production, or ownership." This appears to be equally true of the word "Antarctica."

There is thus good authority for holding that even at common law, a geographical name having no other meaning was never a proper trade-mark. The present case, therefore, is not one of an undisputed and universally recognized common law principle and, accordingly, even if the common law were to be read into the statute, there is no reason for applying the law as interpreted by the authorities relied on by the appellant, rather than as interpreted by the authorities just cited.

Finally, it is not clear that appellant's use of the word "Antarctica" would be regarded as fanciful by all prospective purchasers. Certainly there is no inherent reason why some ingredient of a beverage might not, now or later, be obtained from Antarctica

and, since the purchasers of beverages are not invariably of high or even average intelligence there is good reason to suppose that some of them might assume that the name was connected with the origin of the goods.

CONCLUSION

It is submitted that registration of appellant's mark was properly refused and that the decision appealed from should be affirmed.

Respectfully submitted.

W. W. COCHRAN,
Solicitor, United States Patent Office,
Attorney for Appellee.

E. L. REYNOLDS,
Of Counsel.

SEPTEMBER 1944.